

REMARKS/ARGUMENTS

Claims 1-4, 6-17, 19-29, 31-37 and 39-42 stand rejected in the outstanding Official Action. Applicants have cancelled without prejudice claims 35-37 and 39-42, and amended claims 1-4, 6-11, 13-17, 19-24, 26-29 and 31-34. Accordingly, claims 1-4, 6-17, 19-29 and 31-34 are the only claims remaining in this application.

The Examiner's indication of withdrawal of the drawing objection and abstract objection in view of Applicants' submissions is very much appreciated. The withdrawal of the various claim objections and rejections under 35 USC §112 is also very much appreciated.

In section 12 on page 3 of the Final Rejection, the Examiner now objects to the title of the invention as not being descriptive. Applicants have amended the title to read "GENERATING CONDITIONAL SOFTWARE TEST INSTRUCTIONS FOR USE IN GENERATING SOFTWARE TEST INFORMATION." However, Applicants are not wedded to this particular language and should the Examiner believe another title more accurately reflects the subject matter of the invention, Applicants will certainly consider any such alternative.

In section 13 of the Final Rejection, claims 1-4, 6-17 and 19-27 are objected to because of various informalities. Specifically, in claims 1 and 14 the limitation "said sequence of generated instructions" is objected to. Applicants appreciate the Examiner's suggestion to amend this phrase to read "said corresponding sequence of generated instructions" and notes that claims 1 and 14 have been so amended, thereby obviating any further objection thereto. Claims 2-4 and 6-13 depend on claim 1 and claims 15-17 and 19-26 depend on claim 14. Accordingly, the above amendments to claims 1 and 14 obviate any further objection to these claims.

Claim 27 is objected to as needing a comma between “condition code” and “wherein.”

While “wherein” has been cancelled in the above amendment, the comma has been added, as it is still believed appropriate. The Examiner’s pointing out this typographical error is appreciated.

In view of the above amendments, claims 1-4, 6-17 and 19-27 are believed to meet all PTO requirements for claim language punctuation and any further objection thereunder is respectfully traversed.

In paragraph 15 of the outstanding Final Official Action, claims 27-29 and 31-34 stand rejected under 35 USC §112 (first paragraph), with the Examiner contending that the subject matter “generate[ing] software test instructions” is considered critical language of the claims. Specifically, claim 27 is objected to as not relating the phrase “generating software test instructions” with the subsequent recited steps in the claim.

Claim 27 has been amended to clearly interrelate the preamble reference to generating software test instructions to the subsequent recited steps, i.e., in the phrase “generating . . . a corresponding sequence of generated instructions as said software test instructions,” thereby clearly interrelating the preamble and the recited method steps. Any further rejection to claim 27 or claims dependent thereon under 35 USC §112 (first paragraph) is respectfully traversed.

In section 17 on page 5 of the Final Rejection, claims 27-29 and 31-34 stand rejected under 35 USC §112 (second paragraph) as omitting essential steps, although the objection is believed to be on the same grounds as the rejection under §112 (first paragraph) noted above. Applicants have amended the claim to clearly recite the step of “generating, . . . a corresponding sequence of generated instructions as said software test instructions, . . .” which is believed to clearly obviate this objection to claim 27 as well. Accordingly, any further rejection of claim 27 or claims dependent thereon under 35 USC §112 (second paragraph) is respectfully traversed.

Beginning on page 6, section 9 of the Final Rejection, claims 1-4, 6, 10-17, 19, 23-29, 31, 35-37 and 39-42 stand rejected under 35 USC §102(a) as being anticipated by Applicant Admitted Prior Art (AAPA). The Court of Appeals for the Federal Circuit has noted in the case of *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984) that "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

In the first full paragraph on page 27 of the Final Rejection, the Examiner appears to indicate that the Examiner is construing the claim "corresponding condition code" in an exceptionally broad manner so as to encompass the "special instruction" disclosed in the AAPA. Applicants have amended the current independent claims to preclude such a broad interpretation by specifying that the "generated instruction" has "a generated opcode including said condition code." At least in view of these amendments to the independent claims, Applicants do not believe it is reasonable, given the plain meaning of the claim words, to consider the substitute special instruction of AAPA as being the same as the "generated opcode including said condition code."

Applicants have taken care in the amendments to independent claims 1, 14 and 27 to amend the claims to limit their construction to that recited in the claims in order to further distinguish AAPA from the claimed invention. It is not believed reasonable given the current construction of the claims to consider the "condition code" to encompass the special instruction as disclosed and discussed in the AAPA.

The Examiner suggests on pages 27-29 of the Official Action that Applicants' argument that the AAPA fails to anticipate Applicants' claims is somehow improper for an anticipation

rejection. If the cited prior art does not disclose the claimed element, then, under the *Lindemann* test noted above, the claims cannot be anticipated.

If in fact the cited prior art teaches away from the claimed invention, i.e., teaches a software solution rather than the claimed a hardwired solution, this would appear to be the epitome of a traversal of an anticipation rejection. Not only does the prior art not contain the recited claim element (a hardwired solution), but would actually and actively lead one of ordinary skill in the art to some different solution (a software solution). Such is the case with Applicants' claim language which positively recites a determining step which uses a check "performed in hardware by said target processor upon said condition code within said generated opcode" (emphasis added). Applicants have added this clause in the independent claims in order to clearly define over the cited AAPA.

In view of the above clarification of the "original instructions" and "generated instructions" and the "condition code" as well as the "performed in hardware" requirement, it is believed clear that independent claims 1, 14 and 27 clearly distinguish over the AAPA and that the AAPA does not support any further rejection under 35 USC §102.

In section 21 on page 16 of the Final Rejection, claims 7-9, 20-22 and 32-34 stand rejected under 35 USC §103 as being unpatentable over AAPA combined with Schepers (U.S. Patent 5,712,996). Inasmuch as these claims depend from independent claims 1, 14 or 27, the above comments distinguishing the independent claims from the AAPA are herein incorporated by reference. However, as noted above, these independent claims are believed to be clearly patentable over the AAPA and therefore there is no disclosure because disclosure of all claimed method steps and apparatus elements is absent in the AAPA.

The Examiner does not allege that the missing method steps or elements or interrelationships therebetween in the independent claims are somewhere disclosed in the Schepers reference. Accordingly, even if AAPA and Schepers were to be combined (and it is noted that the Examiner does not provide the required explicit “analysis” of his rationale for combining these references), the combination does not disclose all claimed elements and method steps of the independent claims.

Additionally, as noted above, AAPA, in teaching a software embodiment, would lead one of ordinary skill in the art away from Applicants’ claimed hardware device and its unexpected benefits. As is well known, the fact that a prior art reference “leads away” from the claimed invention is a rebuttal of any *prima facie* case of obviousness and therefore any further allegation of obviousness is respectfully traversed.

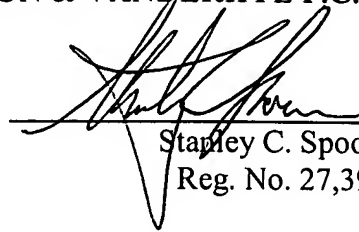
Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that remaining claims 1-4, 6-17, 19-29 and 31-34 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact applicant's undersigned representative.

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Respectfully submitted,

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